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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/738,366 | 12/17/2003 | Frank Akselberg | MRKS/0132 | 8553 |

7590 10/23/2006

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| EXAMINER |
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SMITH, MATTHEW J

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| ART UNIT | PAPER NUMBER |
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3672

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/738,366 | Applicant(s) AKSELBERG, FRANK | |
| | Examiner Matthew J. Smith | Art Unit 3672 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37.CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 9 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 9, 12, 14, and 15 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The amendment filed 11 October 2006 has been entered.

The Final rejection, mailed 11 August 2006, has been withdrawn for a new rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7, 9, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leismer et al. in view of Kilgore (6651749).

Leismer et al. disclose, in figure 21, control system 248 transmitting the pressure, via flow rate (oscillation), of downhole working fluid 246 to the hydraulic fluid 250 (col. 27, lines 22-67); pressure relief valves 198, 200, 202, 204 each opening at higher pressures (col. 26, lines 60-64); valves provide flow to actuators 252, 254, 256, 258; dividing piston 14 (Fig. 1); throttle valve 18; and the hydraulic fluid and working fluid are at the same pressure (before actuation) but not a booster having the one end's area greater than the other end's area.

Kilgore presents the area of a dividing piston 10, acted on by the working fluid, larger than the area of the piston acting on the hydraulic fluid so that the pressure of the hydraulic fluid is higher than the pressure of the working fluid; the pressure from the working fluid transmitted to the hydraulic fluid by means of a booster (fig. 1); and the dividing piston forms part of a booster.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a booster, as presented by Kilgore, in the Leismer et al. system in order to increase pressure sufficient to operate a downhole device without the necessity of increasing tubing pressure (Kilgore, col. 1, line 50-53).

The combination would have been obvious to the method of transmitting pressure of a working fluid to a hydraulic fluid by a dividing piston with the piston having the working fluid side surface area larger than the hydraulic fluid side surface area, also to operate without increasing tubing pressure.

Allowable Subject Matter

Claim 13 is allowed.

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 11 October 2006 have been fully considered but they are not persuasive. Upon further review, the examiner contends one of ordinary skill would have incorporated the Kilgore downhole booster structure for the purpose intended, without changing the operation of the Leismer et al. system. The booster transmitting working fluid pressure to the hydraulic fluid is not dependent upon the source of hydraulic fluid. Thus, the combination is considered to sustainable. The examiner apologizes for not advancing prosecution.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 571-272-7034. The examiner can normally be reached on T-F, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3672

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

MJS
19 October 2006